

Customer No. 22,852
Application No. 10/743,52
Atty. Docket No. 04329.3210

REMARKS

In the Office Action identified above, the Examiner rejected claims 1-28 and 35 under 35 U.S.C. 103 (a) as being unpatentable over Satoru et al. (Japanese Publication 06-244091, "Satoru") in view of Kim (U.S. Patent No. 6,447,688, "Kim").

By this amendment, Applicant has amended claims 1, 9, 14, 19, 24, 28 and 35 to more appropriately define the invention, and has added new claim 36 to protect additional aspects of the present invention. As a result, claims 1-36 are pending, of which claims 1-28 and 35 are under current examination. Claims 29-34 have been withdrawn from consideration.

Applicants respectfully traverse the Examiner's rejection of claims 1-28 and 35 under 35 U.S.C. 103 (a) as being unpatentable over Satoru in view of Kim. A *prima facie* case of obviousness has not been established.

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). M.P.E.P. § 2142, 8th Ed., Rev. 4 (October 2005), p. 2100-134.

A *prima facie* case of obviousness has not been established because, among other things, Satoru and Kim, taken alone or in combination, fail to teach or suggest

each and every element recited in independent claims 1, 9, 14, 19, 24, 28 and 35. In particular, with regard to claim 1, both Satoru and Kim fail to teach or suggest, at least, the claimed "third opening formed in one of the conductive thin film and the conductive support and the insulating film," and "conducting member formed in the third opening excluding an inner wall of the first openings," as recited in claim 1.

Satoru appears to disclose a transparency mask in Figs. 1 and 2, including a thin film-like Si substrate 3, a first SiO₂ film 2, a Si housing 1F, transparency hole patterns 9A-9C, a mask pattern formation field demarcation aperture 7, and a tungsten film 12 formed on inner walls of the transparency hole patterns 9A-9C. The Examiner contends that the transparency hole patterns 9A-9C and the mask pattern formation field demarcation aperture 7 correspond to the claimed first openings and second opening, respectively. Office Action at pages 2-3. However, even assuming, *arguendo*, that the transparency hole patterns 9A-9C and the mask pattern formation field demarcation aperture 7 of Satoru correspond to the claimed first openings and second opening, Satoru fails to teach a **third opening**, and thus necessarily fails to teach or suggest the claimed "third opening," and "conducting member formed in the third opening excluding an inner wall of the first openings," as recited in claim 1.

Kim also does not teach or suggest the claimed "conducting member formed in the third opening excluding an inner wall of the first openings," as recited in claim 1. Kim shows, in Figs. 2A-2F, a stencil mask including an SOI wafer 30 comprising a buried oxide film 22 and a silicon film 23 on a silicon substrate 21, and an alignment

window 33 formed by etching the silicon substrate 21 under an alignment key 23b. However, the alignment window 33 of Kim is formed only in the substrate 21 and **not** in the buried oxide film 22. Kim, col. 3, lines 58-62. Indeed, the alignment window 33 is a window that allows optical transmission through the transparent buried oxide film in order to verify proper alignment of a resist pattern 35. Kim, col. 4, lines 15-26. Moreover, Kim is entirely silent as to any teaching of a conducting member formed in the alignment window 33, and thus necessarily fails to teach or suggest the claimed "third opening," and "conducting member formed in the third opening excluding an inner wall of the first openings," as recited in claim 1.

Since the references taken separately or combined fail to teach or suggest each and every element recited in independent claim 1, no *prima facie* case of obviousness has been established regarding claim 1. Claim 1, and claims 2-8, which depend from claim 1, are thus allowable over the cited references. Moreover, independent claims 9, 14, 19, and 24, while of different scope, recite features similar to those recited in claim 1. Therefore, claims 9, 14, 19, and 24 are also allowable over the cited references for the reasons established above in regard to claim 1, and dependent claims 10-13, 15-18, 20-23, and 25-27 are allowable at least due to their corresponding dependence from claim 9, 14, 19, or 24.

Regarding independent claims 28 and 35, although the Examiner admits that Satoru "does not explicitly disclose an opening in the outside region" (Office Action at pages 15 and 17), the Examiner relies on Kim to teach "an opening 33 formed in the

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outside region." Office Action at pages 15 and 17. However, as discussed above, the alignment window 33 of Kim is formed only in the substrate 21 and **not** in the buried oxide film 22. Therefore, the opening 33 of Kim **cannot** constitute the claimed "opening formed in the conductive thin film and the insulating film corresponding to a part of the second region," as recited in claim 28 and similarly recited in claim 35. In addition, since there is no teaching or suggestion as to a conducting member formed in the alignment window 33, Kim additionally fails to teach or suggest the claimed "conducting member formed ... in the opening" of claims 28 and 35. Accordingly, claims 28 and 35 are allowable over the cited references.

In view of the foregoing amendments and remarks, Applicant respectfully requests reconsideration and reexamination of this application and the timely allowance of the pending claims.

Please grant any extensions of time required to enter this response and charge any additional required fees to our Deposit Account 06-0916.

Respectfully submitted,

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